

REMARKS

The present Response is intended to be fully responsive to the objections and rejections raised in the Office Action, and is believed to place the application in condition for allowance. Further, the Applicant does not acquiesce to any portion of the Office Action not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

As of the mailing of the present Office Action, claims 1-21 were pending in the application. In the Office Action, the Examiner noted that:

- 1) the drawings of the application are accepted;
- 2) acknowledgement is made of a claim of foreign priority under 35 U.S.C. §119 (d)-(d) or (f) and that all certified copies of the priority documents have been received;
- 3) claim 1 is objected to because of alleged informalities;
- 4) each of dependent claims 4 and 20 is separately rejected under 35 U.S.C. §112 for allegedly containing a limitation for which insufficient antecedent basis exists;
- 5) claims 1-3, 6, 9-14 and 21 are rejected as being allegedly anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,580,524 to Weichmann *et al.* (*Weichmann*); and
- 6) claims 5 and 15-19 are rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Weichmann* in view of U.S. Patent No. 6,429,947 to Laverty *et al.* (*Laverty*).

By this response, each of claims 1, 7, 12, 13, 14, 17, 19 and 20 is amended to more clearly recite the subject matter of the application. No new matter has been added to the application. Of the pending claims of the application, each of claims 1 and 21 is presented in independent form. In view of the above amendments and the following discussion, the Applicant submits that the concerns of the Examiner giving rise to the objection to independent claim 1 for informalities have been fully addressed, that sufficient antecedent basis exists under 35 U.S.C. §112 with respect to each of the limitations recited within all of the pending claims; and that none of the claims now pending in the application is anticipated under the provisions of 35 U.S.C. §102, or

obvious under the provisions of 35 U.S.C. §103. Thus, the Applicant believes that each of the claims now pending in the application is in condition for allowance.

I. APPROVAL OF DRAWINGS

The Examiner stated that the drawings received on August 5, 2003 are approved. The Applicant appreciates and thanks the Examiner for promptly approving the drawings.

II. ACKNOWLEDGEMENT OF FOREIGN PRIORITY CLAIM

The Examiner has further indicated that the priority claim in the application with respect to European Patent Office Application Patent Application No. 02016994.2, filed August 5, 2002, is acknowledged, and that all certified copies of the priority documents have been received. The Applicant appreciates and thanks the Examiner for the prompt acknowledgement with respect to the foreign priority claim, and with respect to receipt of certified copies of related documentation.

III. CLAIM AMENDMENTS

The Applicant has implemented amendments consisting of minor, non-substantive, editorial changes to each of claims 1, 7, 13, 14, 17 and 19. The Applicant has also amended dependent claim 12 to recite that such claim depends directly from claim 21. Still further, the Applicant has amended dependent claim 20 to recite wherein such claim shall depend from claim 19, such that claim 20, while still ultimately dependent from claim 21, now does so only indirectly, as opposed to directly. Support for the subject matter recited in each such as-amended claim is found in the application, as filed, including the claims amendment and related remarks set forth in the concurrently-submitted application paper entitled "Simultaneous Amendment".

IV. OBJECTION TO CLAIM 1

The Examiner objected to claim 1 on the basis of the claim having an improper format, and indicated that appropriate correction is required. More particularly, the

Examiner stated that claim 1 "includes a preposition "In", which makes it a claim that is improper in format. The objection is respectfully traversed.

The Applicant respectfully directs the Examiner's attention to the following provisions of 37 CFR §1.75:

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order: (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) A phrase such as "wherein the improvement comprises," and (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

and to Section 608.01(m) of the Manual for Patent Examination and Procedure (MPEP), in which is set forth, in relevant part:

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

The Applicant respectfully submits that claim 1 is grammatically correct and is otherwise appropriately worded for purposes of receiving due consideration on the merits, and in due course being deemed allowable. Viewed in light of the guidance provided in 37 CFR §1.75(e) and section 608.01(m) of the MPEP, the presence of the preposition "In" in the preamble of claim 1 is part and parcel of an appropriate grammatical construct. In addition, the recitations that follow the claim 1 phrase "the improvement comprising" should be accorded due weight in distinguishing the subject matter of claim 1 over the prior art of record. In such circumstances, the preposition "In" in the preamble of claim 1, far from rendering the format of claim 1 improper, in fact fully supports and contributes to an appropriate format for claim 1. Accordingly, the Applicant respectfully requests that the Examiner reconsider the present objection to claim 1, with a view toward withdrawing such objection and providing the Applicant with prompt notice thereof.

V. REJECTION OF CLAIMS 4 and 20 UNDER 35 U.S.C. §112

The Examiner rejected each of claims 4 and 20 for alleged deficiencies with respect to antecedent bases for claim limitations. More particularly, with respect to

claim 4, the Examiner indicated that there is insufficient antecedent basis for the limitation "the wave lengths are 16 wave lengths in the range of 400 to 700 nm with a respective spacing of 20nm", and with respect to claim 20, there is insufficient antecedent basis for the limitation "wherein the color measurement system in the pre-printing stage and the print shop is equipped with a goniometric measuring geometry". The rejections are respectfully traversed.

Turning first to the claim limitation in question with respect to claim 4, substantially *ipsis verbis* support for such subject matter is set forth in the application as-filed (see, e.g., Detailed Description of the Preferred Embodiments section, page 11, last line to page 12, second line), and the term "wave lengths" is specifically set forth in claim 3. In such circumstances, sufficient antecedent basis exists in claim 3 for the use of the claim term "wave lengths" in claim 4, and support for the full extent of the limitation in question in claim 4 is set forth in the application as filed. Accordingly, the Applicant respectfully requests that the Examiner reconsider the present rejection with respect to claim 4, with a view toward withdrawing such rejection and providing the Applicant with prompt notice thereof.

With respect to the claim limitation in question in claim 20, the Applicant respectfully directs the Examiner's attention to the present amendment of claim 20, by which claim 20 is made dependent not only on claim 21, but also on claim 19. The Applicant submits that, to the extent sufficient antecedent basis may not exist in claim 21 for the claim limitation in question with respect to claim 20, sufficient antecedent basis for same *does* exist in claim 19. In such circumstances, sufficient antecedent basis for the claim limitation in question with respect to claim 20 exists. Accordingly, the Applicant respectfully requests that the Examiner reconsider the present rejection with respect to claim 20, with a view toward withdrawing such rejection and providing the Applicant with prompt notice thereof.

VI. REJECTION OF CLAIMS 1-3, 6, 9-14 AND 21 UNDER 35 U.S.C. §102(e)

The Examiner rejected claims 1-3, 6, 9-14, and 21 as being allegedly anticipated by *Weichmann*. In particular, the Examiner stated that:

Regarding claims 21 and 1, Weichmann discloses a printing process involving two stages, a printing stage and an edition printing stage which comprises in the preprinting stage producing digital original image data which represent an original master (see FIG. 4 (1,3,70) and Col. 4, Line 17-30);

producing the digital printing data from the master image for the printing colors involved in the printing (see Col. 4, Line 17-30);

transmitting the digital printing data to a print shop by way of a data channel (see FIG. 4, Col. 8, Line 6-23 and Col. 8, Line 24-33);

producing the printing plates in the print shop using the digital printing data for use in the edition printing to be carried out in a printing machine (see Col. 5, Line 54-54);

using for the color control of the printing machine test data corresponding to the test image produced by an image wise colorimetric measurement of at least one edition printing sample using a spectral color measurement system (see Col. 4, Line 17-30 and Col. 4, Line 43-57);

transmitting the test image data thus produced in the print shop to the pre-printing stage through a data channel (see FIG. 4, Col. 8, Line 13-17 and Col. 8, Line 24-33);

evaluating the test image data in the pre-printing stage for quality monitoring (see Col. 7, Line 6-14);

transmitting the results of the quality monitoring from the pre-printing stage to the print shop through a data channel (see Col. 7, Line 6-14, Col. 8, line 6-23 and Col. 8, Line 24-33); and

using [] in the printing shop the results of the quality monitoring transmitted from the pre-printing stage for at least one of the release of the edition printing and the control of the printing process (see Col. 7, Line 6-14, Col. 8, Line 6-23 and Col. 8, Line 24-33).

The rejection is respectfully traversed.

The above-mentioned lines and additionally Figure 4 of *Weichmann* show a pre-press stage 70 supplying image data 2 to be printed to a raster image processing (RIP) unit 3 which adjusts the image data 2 to the current parameters of the printing machine 1. The adjusted image data are then supplied to the printing machine 1 via the bit-map memory 4. Furthermore, Figure 4 shows that the printing machine 1 sends meta data about a print job to the raster image processing unit 3, that the raster image processing

unit 3 uses these meta data to adjust the image data 2 to the current parameters of the printing machine 1, and that the raster image processing unit 3 subsequently sends these image data as print data to the bit-map memory 4, which in turn provides said data to the printing machine 1. (See *Weichmann*, column 4 lines 16-30).

The Applicant respectfully submits that the meta data respectively transmitted with the job ticket 50, 51 and mentioned in column 8, lines 6 to 12 of *Weichmann* do not contain any image data. More particularly, since meta data are, so to speak, data about data, there is no reasonable basis upon which to conclude that the meta data of *Weichmann* contains any image data, as the latter term is understood by those of ordinary skill in the art, and/or as the latter term is employed in the context of the present application. For instance, to the extent it is the Examiner's position that the meta data of *Weichmann* constitutes data about image data, such meta data would nonetheless not constitute image data, but rather would represent such information as the size of an image, the number of colors in an image, color deviation, processing information, job name, etc. To repeat, such metadata do not, however, comprise the image data proper. The Applicant's observations in this regard are evidenced in *Weichmann* with respect to its teachings regarding the use of the bit-map memory 4 via which the image data 2, adjusted to the current parameters of the printing machine 1, are provided to the printing machine 1.

Weichmann does not teach each and every element of the Applicant's invention recited in any of the presently pending claims. For example, each of independent claims 1 and 21 recite, *inter alia*, both "transmitting the test image data ... in the print shop to the pre-printing stage", and "evaluating the test image data in the pre-printing stage for quality monitoring". *Weichmann*, by contrast, fails to teach or suggest either of "transmitting the test image data ... in the print shop to the pre-printing stage", or "evaluating the test image data in the pre-printing stage for quality monitoring", as required by each of claims 1 and 21. Further, and as a consequence of such deficiencies, in the pre-press stage 70 of *Weichmann*, the image to be currently printed cannot be visually inspected. Still further, to the extent it is the Examiner's position that a prediction as to how the image might look could be made in accordance with the teachings of *Weichmann*, such a prediction could never represent the real image in the

printing machine, but at most perhaps only an approximation of the real image on the basis of the meta data and the original image data.

In other words, in *Weichmann*, the color profile is determined in accordance with the printing conditions and a subsequent check is made as to whether the correct profile has been determined. By contrast, and for example, in accordance with the disclosure of the present application, the measured image data of a print of the printing machine may be advantageously compared with the image data of the pre-printing stage, the image data may then be regulated, and the measured image data may then be provided to a customer, to authorize the printing of the image data.

Further in this regard, and to the extent the same may be of assistance to the Examiner in determining the patentability of each and/or all of the presently pending claims, the Applicant directs the Examiner's attention to related proceedings in the EP application corresponding to the present U.S. application, and more particularly, to the fact that, based on that EP application, the European Patent Office has granted to Applicant European Patent No. 1,388,418.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). Since *Weichmann* fails to teach or suggest, *inter alia*, either of "transmitting the test image data ... in the print shop to the pre-printing stage", or "evaluating the test image data in the pre-printing stage for quality monitoring", each of which is required by each of independent claims 1 and 21.

Accordingly, the Applicant submits that each of claims 1 and 21 is patentable over *Weichmann*, and respectfully request withdrawal of the present rejection under Section 102(e). The Applicant further respectfully submits that each of the respective methods of independent claims 1 and 21 provides patentably distinct results that are not achieved and/or achievable with any variation of the respective method of *Weichmann*. For at least this additional reason, the Applicant submits that each of independent claims 1 and 21 presented herein is patentable over all art of record, including specifically *Weichmann*.

Claims 3, 6, 9-14 depend, either directly or indirectly, from claim 21, and recite additional features therefor. At least since *Weichmann* does not anticipate the Applicant's invention recited in claim 21, *Weichmann* also fails to anticipate the Applicant's invention recited in any of dependent claims 3, 6 or 9-14. Moreover, the Applicant submits that each of the respective methods of claims 3, 6 or 9-14 provides patentably distinct results that are not achieved and/or achievable with any variation of the respective method of *Weichmann*. For at least this additional reason, the Applicant submits that each of the dependent claims presented herein is patentable over all the art of record, including specifically *Weichmann*. Accordingly, the Applicants contend that each of claims 3, 6 or 9-14 is patentable over *Weichmann*. The Applicants respectfully request withdrawal of the present anticipation rejections of claims 1, 3, 6, 9-14 and 21.

IV. REJECTION OF CLAIMS 5 AND 15-19 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 5 and 15-19 as being allegedly obvious over *Weichmann* in view of *Laverty*. In particular, the Examiner stated that "*Weichmann* discloses calculating a test image on the basis of a test image data transferred to the pre-printing stage". The Examiner further recites certain shortcomings of *Weichmann* allegedly supplied by corresponding teachings of *Laverty*. The rejection is respectfully traversed.

As the Examiner is aware, to establish a *prima facie* case of obviousness, one of the basic criteria that must be met is that the prior art reference (or references when combined) must teach or suggest all the claimed limitations. *In re Vaeck*, 947 F. 2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, a *prima facie* case of obviousness has not been established, at least because independent claim 21, from which claims 5 and 15-19 depend, recites a method includes limitations not taught nor suggested in either of *Weichmann* or *Laverty*, whether taken alone or in combination.

In reciting the alleged teachings of *Laverty* to compensate for the shortcomings in *Weichmann*, the Examiner, focusing on the respective limitations of the dependent claims, fails to demonstrate wherein *Laverty* teaches or suggests anything with respect to either of "transmitting the test image data ... in the print shop to the pre-printing

stage", or "evaluating the test image data in the pre-printing stage for quality monitoring", each of which (see above) is required by independent claims 21. In such circumstances, *Laverty* would appear to fail, *inter alia*, to teach or suggest a modification to the teachings of *Weichmann* that would yield a method including either of "transmitting the test image data ... in the print shop to the pre-printing stage", or "evaluating the test image data in the pre-printing stage for quality monitoring", as required by independent claim 21. As such, a *prima facie* case of obviousness has not been established because the combination of the cited references fails to yield a method that includes all of the limitations recited in independent claim 21. Thus, the Applicants respectfully submit that independent claim 1 is patentable over *Weichmann* in view of *Laverty*.

Claims 5 and 15-19 depend, either directly or indirectly, from claim 21, and recite additional features therefor. At least since the subject matter of independent claim 21 is not obvious in view of the cited combination of *Weichmann* and *Laverty*, the subject matter of claims 5 and 15-19 is similarly not obvious in view thereof. Accordingly, the Applicants respectfully submit that each of claims 5 and 15-19 is patentable over all the art of record, including specifically the cited combination of *Weichmann* and *Laverty*. The Applicants respectfully request that the present obviousness rejections of claims 5 and 15-19 be withdrawn, and the claims allowed.

CONCLUSION

In view of the foregoing, the Applicants submit that the Examiner's concerns leading to the present objection to claim 1 and the present rejections of claims 4 and 20 under 35 U.S.C. §112 have been fully and completely addressed, and that none of the claims presently in the application is anticipated under the provisions of 35 U.S.C. §102, or obvious under the provisions of 35 U.S.C. §103. Consequently, the Applicants believe that each of these claims is presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Office believes that any unresolved issues still exist or if, in the opinion of the Office, a telephone conference would expedite passing the present

application to issue, the Office is invited to call the undersigned attorney directly at 203-399-5920 or the office of the undersigned attorney at 203-399-5900 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Date: November 14, 2007



Basam E. Nabulsi
Reg. No. 31,645
Attorney for Applicants

MCCARTER & ENGLISH LLP
Financial Centre, Suite 304A
695 East Main Street
Stamford, CT 06901-2138
203-399-5920
203-399-5820 (fax)
bnabulsi@mccarter.com